REMARKS

Applicant has considered all points made by the examining attorney in the Office Action and has responded to same in order to ensure compliance with the applicable rules.

1. 35 U.S.C. § 102 – Anticipation.

Claims 1-3, 5, 6, 9, and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Reference B3 as illuminated by Reference C1. Applicant respectfully traverses.

Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the examining attorney to identify in a single prior art reference disclosure of each and every element of the claims in issue, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); *In re Schaumann*, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue). When determining if a prior art reference anticipates a claim containing elements expressed as a means for performing a function pursuant to 35 U.S.C. § 112, last paragraph, "the limitations which must be met are those set forth in each statement of function." *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1445 n.5, 221 U.S.P.Q. 385, 389 (Fed. Cir. 1984). When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, the reference does not anticipate. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 107 S.Ct. 2490 (1987).

Applicant's claim 1, as amended, calls for the removal of at least some of the liquid from the oil and gas waste material prior to mixing the oil and gas waste material with the aggregate. Support for this step may be found in the original specification. Neither Reference B3 nor Reference C1 disclose the step of removing at least some of the liquid from the oil and gas waste material. Because this element is recited in Applicant's claim 1 but not disclosed in the references, the references cannot anticipate Applicant's claim 1.

In light of the above, Applicant respectfully submits that claim 1 (as amended) is not anticipated by Reference B3. Because the remainder of the claims depend from claim 1, these claims are also not anticipated by Reference B3. Accordingly, Applicant respectfully requests the

examining attorney to withdraw the rejection of claims 1-3, 5, 6, 9, and 10 under 35 U.S.C. § 102(b) in view of Reference B3..

2. **35 U.S.C § 103(a) Rejection – Claims 4.**

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Reference B3 and Reference C1 in view of CHEMICAL ENGINEER'S HANDBOOK.

Applicants respectfully traverse this objection. According to the Manual of Patent Examining Procedure:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Manual of Patent Examining Procedure, § 2143.

As indicated above, neither Reference B3 nor Reference C1 disclose the step of removing at least some of the liquid from the oil and gas waste material. The step is also not disclosed in the CHEMICAL ENGINEER'S HANDBOOK. To make Applicant's claimed invention obvious, the cited references must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Because this element is recited in Applicant's claim 1 but not disclosed in any of the references, the references cannot claim 4, which depends from claim 1, obvious. Therefore, claim 4 should now be allowable.

Applicant respectfully requests the examining attorney to withdraw the obviousness rejection of claim 1.

3. **Double Patenting.**

The examining attorney has provisionally rejected claims 1-3, 6 and 9 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent Application Serial No. 10/801401.

A terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) is filed herewith.

CONCLUSION

The Applicant appreciates the examining attorney's attention to this application. This is intended to be fully responsive to all matters raised in the Office Action. In view of Applicant's amendments and arguments set forth above, it is respectfully submitted that all pending claims are allowable, and a Notice of Allowance is respectfully requested. If any matter remains to be resolved the examining attorney is invited to call the Applicant's attorney to expeditiously conclude prosecution.

Respectfully submitted,
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CERTIFICATE OF MAILING

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37 CFR 1.8(a)	37 CFR 1.10
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